

**REMARKS**

The Examiner objected claims 2-7, 15-20 and 22-27 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner allowed amended claims 28-32 over prior art of record. Applicants gratefully acknowledge the Examiner's indication of allowable subject matter.

The Examiner rejected claims 1, 8-11 and 14 under 35 U.S.C. §102(b) as allegedly being anticipated by Coolbaugh et al. (US 2002/0185708).

The Examiner rejected claim 21 under 35 U.S.C. §102(b) as allegedly being anticipated by Emons et al. (US 6,100,152).

The Examiner rejected claims 1, 12 and 13 under 35 U.S.C. §102(e) as allegedly being anticipated by Khater et al. (US 2004/0188797).

Applicants respectfully traverse the §102 rejections with the following arguments.

**35 U.S.C. §102**

In the Final Office Action mailed May 4, 2005, the Examiner maintains the rejection of claims 1, 8-11 and 14 under 35 U.S.C. §102(b) as allegedly being anticipated by Coolbaugh et al. (US 2002/0185708).

Applicants respectfully continue to contend that Coolbaugh does not anticipate claim 1, because Coolbaugh does not teach each and every feature of claim 1. Applicants repeat their arguments (made in their response filed February 21, 2005) as below for the Examiner's convenience.

"For example, Coolbaugh does not teach the step of "(b) if a first yield of the first plurality of identical semiconductor structures is not within a pre-specified range of a target yield, forming a second plurality of identical semiconductor structures...." Here, the step of "forming a second plurality of identical semiconductor structures" is a conditional step which is performed if the if condition in step (b) of claim 1 is satisfied. In contrast, Coolbaugh does not teach any conditional step based on a condition of a yield.

In bullet number 2 of the Office Action, the Examiner alleges that "independent claims 1 and 14 recite an "if" condition, which include an option where the first yield of the first plurality of identical semiconductor structures is within a pre-specified range, leading to a second run to form a second plurality of identical semiconductor structures being not carried out. In this instant, the reference reads on every limitation of the claims."

Applicants respectfully maintain that claim 1 does not explicitly or impliedly include such

a conditional step as alleged by Examiner. More specifically, claim 1 does not explicitly or impliedly include the alleged step of not forming the second plurality of identical semiconductor structures if the first yield is within the pre-specified range."

In response to Applicants' arguments above, the Examiner alleges, in the final Office Action mailed on May 4, 2005, that "The Examiner agrees that Coolbaugh does not teach step (b). However, as noted in the rejection, step (b) of claim 1 is not necessarily always carried out because of the "if" condition. Particularly, step (b) implies two alternatives: (1) If a first yield is not satisfied then forming a second plurality of identical semiconductor structure. (2) If a first yield is satisfied then the step of forming a second plurality of identical semiconductor structure is not necessarily."

From the Examiner's arguments above, Applicants have the impression that the Examiner is trying to apply the Markush group argument to step (b) of claim 1. In other words, the Examiner alleges that step (b) of claim 1 comprises a Markush group of two small steps: step (1) and step (2) mentioned above, and that, because step (2) of the Markush group is anticipated by Coolbaugh, therefore the entire Markush group (i.e., step (b) of claim 1) is also anticipated by Coolbaugh.

Applicants agree that if an element of a Markush group is anticipated by a prior art reference, the entire Markush group is anticipated by the reference. However, as Applicants previously argued, step (b) of claim 1 does not explicitly or impliedly include the alleged step (2) mentioned above (i.e., the step of not forming the second plurality of identical semiconductor structures if the first yield is within the pre-specified range). In other words, claim 1 does not say

anything about what happens if a first yield is within the pre-specified range. On this point, the Examiner states, in the final Office Action mailed on May 4, 2005, that "it is well settled that the claims have to be read in light of the specification in order to determine the scope of the invention. In this respect, paragraphs [0027]-[0028] of the specification clearly indicates such alternatives. In the case of 2), Coolbaugh's reference reads on the claimed limitation as noted in the rejection." Applicants respectfully disagree. Contrary to the Examiner's belief, it is well-settled by court decisions that the limitations in specification are not to be incorporated into claims, and that the scope of a claim must be construed from the language of the claim itself.

In addition, even if the step (b) of claim 1 includes the alleged step (2) mentioned above (which Applicants deny), the two steps (1) and (2) mentioned above do not comprise a Markush group.

To support Applicants' arguments, Applicants would like to give an example. Assume that an inventor invents an inverter having an input and an output, wherein the inverter (i) generates a 1 at its output if the inverter receives a 0 at its input and (ii) generates a 0 at its output if the inverter receives a 1 at its input. If the Markush group argument mentioned above could be used to reject claims, it would be impossible to claim the inverter invention. More specifically, whatever is claimed in the claim for the inverter, there would be an implied step for the inverter to do nothing (or not to do what it is supposed to do, i.e., inverting) if there is no signal applied to its input. This implied step of doing nothing would be easily anticipated by a prior art reference.

As a result, the entire claim for the inverter would be anticipated by the reference. This line of rejection arguments would be unacceptable by a court. Therefore, Applicants urge that the

Examiner not use such Markush group argument to reject claim 1.

Applicants also note the Examiner's argument that "However, as noted in the rejection, step (b) of claim 1 is not necessarily always carried out because of the "if" condition." This gives Applicants the impression that the Examiner is trying to say that the "if" condition of step (b) of claim 1 makes step (b) equivalent to nothing (i.e., not qualified as a limitation), leaving step (a) as claim 1's only limitation, and that because step (a) is anticipated by Coolbaugh, the entire claim 1 is anticipated by Coolbaugh. Applicants respectfully disagree. On the one hand, contrary to the Examiner's belief, it is well-settled that a conditional step is in fact a limitation. On the other hand, as argued in the example of the inverter invention above, this line of rejection arguments would be unacceptable by a court because this line of rejection arguments would make it impossible to get a patent for almost anything. More specifically, this line of rejection arguments would infer that the inverting feature of the inverter in the example above is not a limitation just because the inverter does nothing if no signal is applied to its input. Without the inverting feature in the claim for the inverter, the claim for the inverter would be easily anticipated by prior art references. As a result, Applicants urge that the Examiner not reject claim 1 based on the argument that the "if" condition makes step (b) of claim 1 equivalent to nothing.

Based on the preceding arguments, Applicants respectfully maintain that Coolbaugh does not anticipate claim 1, and that claim 1 is in condition for allowance. Since claims 8-11 depend from claim 1, Applicants contend that claims 8-11 are likewise in condition for allowance.

Based on similar arguments, Applicants respectfully maintain that Coolbaugh does not anticipate claim 14, and that claim 14 is in condition for allowance.

10/709,644

18

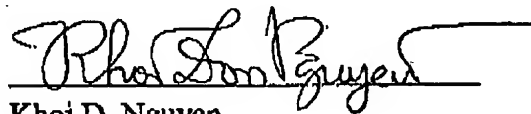
Based on similar arguments, Applicants respectfully maintain that Emons does not anticipate claim 21, and that claim 21 is in condition for allowance.

Based on similar arguments, Applicants respectfully maintain that Khater does not anticipate claim 1, and that claim 1 is in condition for allowance. Since claims 12 and 13 depend from claim 1, Applicants contend that claims 12 and 13 are likewise in condition for allowance.

**CONCLUSION**

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0456.

Date: July 5, 2005



Khoi D. Nguyen

Registration No. 47,820

Schmeiser, Olsen & Watts  
3 Lear Jet Lane, Suite 201  
Latham, New York 12110  
(518) 220-1850